IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Uemura et al.

Serial No.: 09/935,699 Group Art Unit: 1733

Filed: August 24, 2001 Examiner: Kornakov, Michael

For: METHOD FOR MANUFACTURING A GROUP III NITRIDE COMPOUND SEMICONDUCTOR DEVICE

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

RESPONSE UNDER 37 C.F.R. §1.111

Sir:

In response to the Office Action dated February 2, 2004, Applicant states as follows:

REMARKS

1) That in an Office Action dated July 30, 2003, the Examiner rejected claims 1-4 under 35 USC 112, second paragraph. Specifically, the Examiner stated that claim 1 did not include essential manufacturing steps. The Examiner also rejected claim 1 under 35 USC 102(b) as allegedly anticipated by the Kern reference, and claims 1-3 and 5-10 under 35 USC 102(b) as allegedly anticipated by the Yamazaki reference. The Examiner also rejected claim 4 under 35 USC 103(a) as unpatentable over the Yamazaki reference in view of the Kern reference.

2) That on October 30, 2003, Applicant filed herein an Amendment which was completely responsive to each and every rejection in the Office Action dated July 30, 2003. Specifically, the 35 USC 112, second paragraph rejection was addressed on page 7 of the Amendment. In addition, the Amendment included amendments to claim 1 to address the Examiner's rejection.

Further, the 35 USC 102(b) rejection based on Kern was addressed on pages 7-8, and the 35 USC 102(b) rejection based on Yamazaki and the 35 USC 103(a) rejection based on the alleged Yamazaki/Kern combination was addressed on pages 8-10 of

the Amendment. In addition, claims 1 and 5 were amended to recite "*wherein said irradiating said surface of said wafer is performed after said patterning said resist layer*", and claim 8 was amended to recite "*after said cutting said wafer, irradiating a surface of said plurality of wafer chips with ultraviolet rays to thereby clean said surface of said plurality of wafer chips*". As explained in great detail in the Amendment, these features are described in detail in the present Application and, moreover, neither the Kern reference, nor the Yamazaki reference nor any alleged combination of these references teaches or suggests these features.

3) In the Office Action dated February 2, 2004, the Examiner surprisingly alleges that the Amendment was not responsive because "currently amended claims 1-7 have absolutely different scope compare (sic) to those initially presented". Applicant respectfully submits that the Examiner misunderstands the meaning of "nonresponsive".

Indeed, 37 CFR 1.111(b) states that:

> "*[i]n order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references*".

In addition, 37 CFR 1.111(c) states that

> "*[i]n amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections*".

Applicant respectfully submits that the Amendment filed herein fully meets the requirements of 37 CFR 1.111 (b) and (c) as set forth above. Indeed, nowhere does 37 CFR 1.111 (or anywhere else in 37 CFR or the MPEP, for that matter) even suggest that changing

the scope of the claims in the Amendment may result in the Amendment being considered non-responsive. In fact, contrary to the Examiner's bizarre allegations, Applicant respectfully submits that in his response to an Office Action, Applicant has every right to amend the claims any way he sees fit, so long as the claims are enabled by the specification and so long as the Amendment explains how the amended claims are not taught or suggested by the cited refereces.

(4) Clearly, there is no basis in 37 CFR 1.111, nor in MPEP 714.02 for the Examiner's allegations that the Amendment filed on October 30, 2003 was non-responsive. Therefore, the Examiner is respectfully requested to respond to Applicant's Amendment filed herein on October 30, 2003.

CONCLUSION

In view of the foregoing, Applicant submits that claims 1-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 3/2/04

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment was filed by facsimile with the United States Patent and Trademark Office, Examiner Michael Kornakov, Group Art Unit # 1733 at fax number (703) 872-9306 this 2nd day of March, 2004.

Phillip E. Miller
Reg. No. 46,060